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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,860	06/11/2001	Tore Danielssen	E-1024	5304

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EXAMINER

LEE, RIP A

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 04/03/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,860

Applicant(s)

DANIELSSEN ET AL.

Examiner

Rip A. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This office action follows a response filed on December 31, 2002. Applicants have amended claims 1-7 and have added new claims 8-20. Claim 14 is a new independent claim.

Drawings

1. The drawings are objected to because photocopies of drawings with copy marks are not acceptable. Also, line markings of the legend are not clear. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2 210 882 to Clarke *et al.*

Clarke *et al.* discloses a particulate filler of wide particle size distribution comprising the following fractions: (i) 2-35 % in the sub-micron range and/or (ii) 30-80 % in the 1-50 μ range and (iii) 5-40 % in the 50-250 μ range. The submicron particulate filler is present as particles

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substantially in the 0.1-1.0 μ range, an example being microsilica (page 6, last line). The 1-50 μ fraction of the filler is quartz powder, fly ash, or talc (page 7, lines 1 and 2). As such, the composition of the filler and the amounts of materials are fully disclosed in the prior art. With respect to the filler's usage, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP § 2111.02. There is no indication that the composition of Clarke *et al.* can not be made into the claimed articles of manufacture. As such, the composition still meets the claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,143,808 to Sack *et al.*

Sack *et al.* teaches a polymer composition comprising a particulate mineral carrier and polymer dispersion. The mineral carrier is selected from talc, microsilica, and mixtures thereof (claim 5), and the polymer is selected from polymers based on vinyl chloride, butadiene, and isoprene (claim 8). The polymer makes up 0.5-30 wt % of the composition. The reference does not teach specifically the use of both talc and microsilica, as recited in the present claims, but one having ordinary skill in the art would find it obvious to use the combination because Sack *et al.* indicates that mixtures of filler can be used. It is maintained that one having skill in the art would find it obvious to arrive at a mixture of at least equal proportions of talc and microsilica (*i.e.*, 1:1 ratio or 50/50 mix), thereby satisfying the weight ratio set forth in the present claims. Also, one would find it obvious to arrive at the notion of adding talc and microsilica simultaneously or separately, especially in view of the fact that there are only two possibilities of adding two materials. Finally, the examples show the process of mixing together (*i.e.*, compounding) filler and resin. Therefore, one having skill in the art would find it obvious to mix filler into resin.

7. Claims 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sack *et al.* in view of U.S. Patent No. 5,844,037 to Lundgard *et al.*

The discussion of the disclosures of the prior art of Lundgard *et al.* from the previous paragraph of this office action is incorporated here by reference. Although the patent teaches mixing of filler and resin in order to form a thermoplastic composition, it does not disclose specifically the use of extrusion to achieve this goal. The use of extruders for compounding is well known in the art, especially where thermoplastic resin compositions is concerned. For example, Lundgard *et al.* shows that polyolefin thermoplastic compositions containing talc and silica filler (claims 1 and 14) can be prepared readily using an extruder (Examples 1-4). Therefore, one having ordinary skill in the art would find it obvious to arrive at the notion of using an extruder to compound the compositions of Sack *et al.*, and one would have expected such a process to work.

Response to Arguments

8. The Applicants traverse the rejection of claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over GB 2 210 882 to Clarke. The Applicant's arguments have been considered fully, and the rejection has been withdrawn.

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Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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March 28, 2003



**DONALD R. WILSON
PRIMARY EXAMINER**